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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/960,032	09/20/2001	Alan J. Lang	D-2821CON	6533
33357	7590	08/23/2005	EXAMINER	
ADVANCED MEDICAL OPTICS, INC.			CHATTOPADHYAY, URMI	
1700 E. ST. ANDREW PLACE			ART UNIT	
SANTA ANA, CA 92705			PAPER NUMBER	

3738

DATE MAILED: 08/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/960,032

Applicant(s)

LANG, ALAN J.

Examiner

Urmi Chattopadhyay

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2004 and 31 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 70-88 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 70-88 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendment filed 11/12/04 and the supplemental amendment filed 5/31/05 in response to the notice of non-compliant amendment have been entered. The changes to the claims have been approved by the examiner. Claims 70-88 are pending and are being considered for further examination on the merits.

Claim Objections

2. Amended claim 84 is objected to because of the following informality: on line 1, it appears that "each of" should be deleted. Appropriate correction is required.

Response to Arguments

3. Applicant's arguments, see pages 7-8, lines 4-23, filed 11/12/04, with respect to the rejection(s) of claim(s) 70 and 81 under 35 U.S.C. 102(e) by Menezes (USPN 6,199,984), have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Portney (USPN 5,720,440). This office action is non-final.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 70-73, 75-81 and 85-88 are rejected under 35 U.S.C. 102(b) as being anticipated by Portney (USPN 5,702,440, as cited in applicant's IDS).

Portney discloses an intraocular lens with all the elements of claims 70 and 81. See Figures 2 and 3 for a single, unitary multifocal lens body (11) sized and adapted for placement in the mammalian eye, and having a central zone (18) with a baseline optical power providing a mean power for distant vision (column 2, lines 39-43) and a plurality of annular regions (19, 20, 21, 22) each having an optical power. See Figure 4 of Portney as being comparable to Figure 3 of applicant for the plurality of annular regions including a region having a first/maximum optical add power for near vision, and a second/additional optical add power intermediate between the first optical add power and the baseline optical add power. See column 4, lines 31-34 for the diopter correction provided being varied with the prescription needs of the patient. Because the diopter correction will vary with the amount of accommodative capability of the natural lens, Portney is clearly suggesting that the IOL be used in an eye including a natural lens having at least some natural accommodative capability. Accordingly, the first/maximum optical add power will have a magnitude so as to provide, in combination with the natural accommodative capability of the natural lens of the eye, enhanced reading vision ability. Each of the optical add powers will also be less than the full optical power required for near reading in a pseudophakic subject.

Claim 71, see Figure 2 for a fixation member (15) coupled to the lens body (11).

Claim 72, see Figure 4 for each annular region having a different optical add power.

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Claim 73, see rejection to claim 81, *supra*.

Claims 75 and 85, see Figure 4 for the lens body (11) not including cylinder correction.

Claims 76-79, 86 and 87 are intended use claims. See Figure 2 for the lens body (11) and fixation member (15) being structurally capable of being placed in the anterior or posterior chamber of the eye.

Claims 80 and 88, see column 3, lines 24-26 for the lens body (11) being deformable for insertion through a small incision into the eye.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 74 and 82-84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Portney in view of Menezes et al. (USPN 5,847,802, as cited in applicant's IDS).

Portney discloses an intraocular lens with all the elements of claims 70 and 81, including that the diopter correction will vary depending on the needs of the individual patient, but is silent to the first/maximum optical add power being reduced by at least 10%, 20% and 50% relative to the optical add power required for near reading in a subject not having a natural lens in place, as required by claims 74 and 82-84. Menezes et al. teaches that for an IOL, "(s)ome patients may not require the full...add powers in these designs. For these cases, the...near powers can be made a fraction (preferably 50%) of the full...add power". See column 4, line 52-55. It would


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have been obvious to one of ordinary skill in the art at the time of applicant's invention to look to the teachings of Menezes et al. to modify the IOL of Portney by having the first/maximum optical add power reduced by at least 50%, which is at least 10% and 20%, in order to meet the needs of the patient when full optical add power is not required.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Urmi Chattopadhyay whose telephone number is (571) 272-4748. The examiner can normally be reached on Tuesday-Thursday 10:00am - 6:00pm.

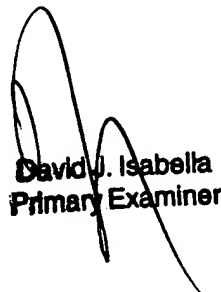
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Urmi Chattopadhyay

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David J. Isabella
Primary Examiner